

III. REMARKS

1. Claims 1 and 18 are amended.

2. Applicant respectfully submits that the rejection of claims 1-34 under the judicially created doctrine of obviousness type double patenting over claims 1-26 of Application No. 10/771,464, is improper.

U.S. Application Serial No. 10/771,464 is assigned to Fuji Photo Film Co., and is directed to an inkjet recording ink. Thus, there is no basis for a double-patenting rejection of Applicant's invention in light of Application Serial No. 10/771,464.

3. Claims 1-16 and 18-33 are not anticipated by Naghian et al. ("Naghian") (U.S. Patent Publication No. 2002/0086682) under 35 U.S.C. §102(e).

Claim 1 is amended to recite using packet-switched connections between the core network, the radio network and the subscriber terminal for transmitting the request message and the response message. These are not disclosed or suggested by Naghian.

Naghian deals with a problem that is different than the problem addressed in the present application. The problem that is solved by Naghian concerns a situation where a direct connection, between the mobile station (MSI) that is to be located and the base station (BS1, BS2, BS3), is not available (Not Line of Sight, see paragraph [0003] of Naghian). Naghian solves this problem by providing fixed relay stations (MSN1-MSN5) which forward signals to target mobile station (MS1).

However, the problem addressed by Applicant is that if known location service methods are used in a packet-switched network,

the 'traditional' signaling that is needed is too heavy and slow. Thus, in Applicant's invention, all the communication required in location services is performed via a packet-switched network (see paragraph [0065] of the present application) and claim 1 recites that "packet-switched connections" are used.

Starting from paragraph [0176] and Figure 8 of Naghian, a mobile originated location request (MO-LR) for circuit calls is described. Figure 8 is also used for a case of a packet switched, mobile terminated location request (MT-LR) where the general procedure is in principle the same except that session management (SM) rather than a connection management (CM) is performed (see paragraph [0191] of Naghian). Thus, all the requests in Naghian use circuit-switched signaling.

However, in Applicant's invention, the information required by the location service is transmitted in the packet-switched domain. The advantage of this technical difference is that there is no need to switch from one domain to another, and thus, the location service becomes faster.

Thus, the features of claim 1 are not disclosed or suggested by Naghian. Claim 18 is similarly amended and its features are also not disclosed or suggested.

Claims 2-16 and 19-33 should be allowable at least by reason of their respective dependencies.

Additionally, with regard to Claims 2 and 19, page 6, paragraph 0117 of Naghian does not teach that the request message may relate to the location service functions. Rather, paragraph 0117 merely relates to position management and the scheduling of

resources to perform position measurements. There is nothing stated therein related to informing an "outside client" of the subscriber terminal location or the transmission of "location assistance data" as is recited by Applicant in the claims. It is also stated in Applicant's invention that the location functions in this embodiment comprise also other functions related to location services than merely the function of locating of a terminal. (see e.g. page 12, paragraph 0058).

With regard to Claims 3 and 20, page 5, paragraph 0088 of Naghian does not teach that the **information included in the request message comprises** "desired quality of service of the requested location service" as is claimed by Applicant. Rather, page 5, paragraph 0088 of Naghian only describes a service in the network that requests location information with a "specified 'QoS'". However, unlike Applicant's invention, the request message sent by the terminal in Naghian **does not include** this information. Thus, the features of the claims are not disclosed or suggested by Naghian. Applicant's invention also describes different information that can be included in the request message. (see e.g. page 12, paragraph 0061).

With respect to Claims 4 and 21, page 4, paragraph 0060 of Naghian only teaches which parts of the RAN can provide, for example, power control. Claims 4 and 21 is related to and specifically recites "information included in the request message." In Naghian however, the request message sent by the terminal **does not include** the "other information" that is specifically recited in claims 4 and 21. Thus, the features of claims 4 and 21 cannot be disclosed or suggested.

Therefore, it is respectfully submitted, that in view of the foregoing, claims 1-16 and 18-33 are not anticipated by Naghian.

4. Claims 17 and 34 are not unpatentable over Naghian (U.S. Patent Pub. No. 2003/0148774) ("Naghian '774") in view of Korpela (U.S. Patent No. 6,311,054) under 35 U.S.C. §103(a).

The Applicant notes that in the Office Action the Examiner has identified Korpela as U.S. Patent No. 6,311,055. This is not correct. U.S. Patent No. 6,311,055 is to Boltz, not Korpela. Korpela belongs to U.S. Patent No. 6,311,054. Clarification is requested.

Nevertheless, the rejection under 35 U.S.C. §103(a) is not valid because Naghian '774 is not prior art against Applicant's invention. As stated in Applicant's prior response, the earliest effective priority date of Naghian '774 is after Applicant's earliest effective filing date. Thus, Naghian '774 cannot be used against Applicant's invention since it is not "**prior**" art.

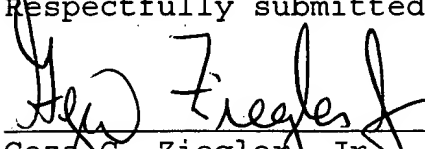
Also, Korpela cannot be used against Applicant's application for patent under 35 U.S.C. §103(c) since both Applicant's invention and Korpela are, and were at the time of Applicant's invention, commonly owned by the assignee of the instant application. Thus, pursuant to 35 U.S.C. §103(c), Korpela is not a proper prior art reference for purposes of 35 U.S.C. §103(a). Therefore, the above-recited rejection of claims 17 and 34 cannot stand.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable

reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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